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UNITED STATES PATENT OFFICE

Patent No. **5,171,534**

Issued: December 15, 1992

On petition requesting issuance of a certificate for correction of inventorship pursuant to 35 USC § 256, it has been found that the above-identified patent, through error and without any deceptive intent, improperly sets forth the inventorship. Accordingly, it is hereby certified that the correct inventorship of this patent is:

Lloyd M. Smith
Leroy E. Hood
Michael W. Hunkapiller
Tim J. Hunkapiller
Charles R. Connell

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Jill Warden

Jill Warden
Supervisory Patent Examiner
Art Unit 1313



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In re Application of
Lloyd M. Smith, et al.
Patent No. 5,171,534
Patent Date: December 15, 1992
For: AUTOMATED DNA SEQUENCING
TECHNIQUE

DECISION ON PETITION

This is a decision on the petition under 37 CFR § 1.324 filed January 29, 1996 for correction of inventorship of the above-identified patent.

This patent issued from U.S. Serial No. 07/558,312, which application is a divisional application of 07/106,232. A review of the record reveals that a prior petition to correct inventorship was filed during the prosecution of 07/106,232. However, that petition was denied. Attempts were made to correct the errors in that petition in the filing a continuation application, 07/898,019. The defect was never corrected and the petition never granted. However, in the filing of a file wrapper continuation of 07/898,019, the Patent Office issued a filing receipt with the corrected inventorship listed thereon. However, no change to the inventorship was made in 07/558,312.

After the issuance of the above-identified patent, U.S. 5,171,534, patentees noted that the inventorship was never corrected in 07/558,312. At that time, patentees filed a request for certificate of correction to add the omitted inventor. This request was denied, as such a change must be made by petition.

On January 29, 1996, the present petition was filed. Petitioner requests amendment of the inventorship to include Charles R. Connell. Petitioner states that the error in omitting inventor Connell occurred without deceptive intent. In support of the petition, a verified statement of facts, signed by the prior-named inventors, indicating when the error in inventorship was discovered and how it occurred, was submitted. Further in support of the petition, a letter of consent from the assignee, a declaration under 37 CFR § 1.63 signed by all named inventors, including inventor Connell, and a check for the \$130.00 petition fee, were submitted. Petitioner requests the inventor Connell be included in the inventorship of the above-identified patent.

DOCKETED

In August 1996, an additional statement of facts from all the original applicants was requested of petitioners in a telephone communication with Jill Warden. A more precise indication of inventor Connell's contribution to the invention was required.

On October 1, 1996, a supplemental verified statement of facts was submitted clearly identifying the contribution of inventor Connell to the claimed invention.

37 CFR § 1.324 states, in part:

"Whenever a patent is issued and it appears that the correct inventor or inventors were not named through error without deceptive intention on the part of the actual inventor or inventors, the Commissioner may, on petition of all the parties and the assignees and satisfactory proof of the facts and payment of the fee set forth in § 1.20(b), . . . issue a certificate naming only the actual inventor or inventors."

M.P.E.P. § 1481 states, in part:

"The "satisfactory proof of facts" required by 37 CFR § 1.324 must be of the same type and character as the proof required under 37 CFR § 1.48 to justify correcting inventorship in an application, as described in MPEP § 201.03."

With respect to the "satisfactory proof of facts," MPEP § 201.03 states:

"The required "statement of the facts verified by all of the original applicants" must include at the least, a recital of the circumstances, including relevant dates, of
(1) the error in naming the actual inventor or inventors and (2) the discovery of the error."

A review of the record reveals that petitioner has complied with all the conditions in 37 CFR § 1.324. The petition is granted. The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming the actual inventors of the above-identified patent, namely, Lloyd M. Smith, Leroy E. Hood, Michael W. Hunkapiller, Tim J. Hunkapiller, and Charles R. Connell.

PETITION GRANTED



Jill A. Warden
Supervisory Patent Examiner
Art Unit 1313

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